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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,118	10/04/2005	Stephen Martin Courtney	CELL-0289	8405
23377	7590	12/15/2006	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			STOCKTON, LAURA LYNNE	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/523,118	COURTNEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Laura L. Stockton, Ph.D.	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-13 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 11-13, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/22/2006</u>   | 6) <input type="checkbox"/> Other: _____                          |

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#### **DETAILED ACTION**

Claims 1-9, 11-13 and 18-27 are pending in the application.

#### ***Election/Restrictions***

Applicant's election with traverse of Group V (claims 20-27 - directed to methods of use) in the reply filed on October 31, 2006 is acknowledged. The traversal is on the ground(s) that: (1) the technical feature that links Groups I-III and V do define a contribution over the prior art; (2) the compound of CA Registry number 39170-33-7 found in Okeink et al. (CA 78:43169, 1973) is not a compound of formula (I); and (3) Groups I-III should be rejoined with Group V into a single group. This is not found persuasive because in determining the special technical feature that defines a contribution over the prior art, every invention in the pending claims is taken into consideration. This would include the compounds found in instant claim 18.

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The claims lack unity of invention for the reasons stated in the previous Office Action. It is agreed that the compound in Okeink et al. is not of formula (I) but is embraced by the genus of formula (II) found in instant claim 18. Additionally, the scope of the claims for the elected methods of use is different than the scope of the products of Group I (note proviso in claim 1). Since Applicant elected the method of use of Group V, the inventions of Groups I-III are not subject to rejoinder practice.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-9, 11-13, 18 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions(s), there being no allowable generic or linking claim. Applicant timely

traversed the restriction (election) requirement in the reply filed on October 31, 2006.

It is suggested that in order to advance prosecution, the non-elected subject matter be canceled when responding to this Office Action.

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

The Examiner has considered the Information Disclosure Statement(s) filed on May 22, 2006.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,

3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

***The nature of the invention***

Applicant is claiming a method for inhibiting heparanase activity, methods for treating cancer and methods of treating angiogenesis, angiogenesis dependent diseases, inflammatory diseases, autoimmune diseases or cardiovascular diseases by administering a compound of formula (I). See, for example, instant claims 20, 21 and 23. From the reading of the specification, it appears that Applicant is asserting that the embraced compounds, because of their mode action which involves the inhibition of heparanase, would be useful for treating all of the

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diseases/disorders mentioned, or generically embraced, above. On page 12, line 27 of the instant specification, "treating" is defined as embracing prophylactic or therapeutic therapy.

***The state of the prior art and the predictability or lack thereof in the art***

The state of the prior art is that cancer therapy, for example, remains highly unpredictable. The various types of cancers have different causative agents, involve different cellular mechanisms, and consequently, differ in treatment protocol. It is known (see Golub et al., Science, Vol. 286, October 15, 1999, pages 531-537) that the challenge of cancer treatment has been to target specific therapies to pathogenetically distinct tumor types, to maximize efficacy and minimize toxicity. Cancer classification has been based primarily on morphological appearance of the tumor and that tumors with similar histopathological appearance can follow significantly



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different clinical courses and show different responses to therapy (Golub et al., Science, Vol. 286, October 15, 1999, pages 531-537). There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

***The amount of direction or guidance present and the presence or absence of working examples***

There is no evidence of record, which would enable the skilled artisan in the identification of the people who have the potential of becoming afflicted with the numerous diseases or disorders claimed herein. That a single class of compounds can be used to treat or prevent all diseases embraced by the claims is an incredible finding for which Applicant has not provided supporting evidence. Applicant has not provided any

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competent evidence or disclosed tests that are highly predictive for the pharmaceutical use for treating or preventing all conditions by administering the instant claimed compounds.

***The breadth of the claims***

The breadth of the claims is treating or preventing of all diseases and disorders generically embraced in the claim language {i.e., a method for inhibiting heparanase activity, methods for treating cancer and methods of treating angiogenesis, angiogenesis dependent diseases, inflammatory diseases, autoimmune diseases or cardiovascular diseases by administering a compound of formula (I)}.

***The quantity of experimentation needed***

The nature of the pharmaceutical arts is that it involves screening in vitro and in vivo to determine which compounds exhibit the desired pharmacological activities for each of the diseases and disorders instantly claimed. The quantity of experimentation

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needed would be undue when faced with the lack of direction and guidance present in the instant specification in regards to testing all diseases and disorders generically embraced in the claim language, and when faced with the unpredictability of the pharmaceutical art. Thus, factors such as "sufficient working examples", "the level of skill in the art" and predictability, etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims.

***The level of the skill in the art***

Even though the level of skill in the pharmaceutical art is very high, based on the unpredictable nature of the invention and state of the prior art and lack of guidance and direction, one skilled in the art could not use the claimed invention without undue experimentation.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

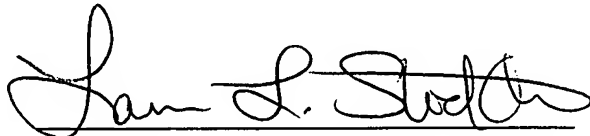
In claim 20, line 4 of claim, the phrase "of prodrug thereof" should be changed to "or prodrug thereof".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", is written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

December 11, 2006